

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL D. RECHTIN

Appeal No. 95-3421
Application 08/045,323¹

ON BRIEF

Before CALVERT, ABRAMS and CRAWFORD, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 9 to 18, 20 and 21². Claims 1 to 8, the other claims remaining in

¹ Application for patent filed April 7, 1993.

² We note that although appellant cancelled claim 19 in the Amendment Under Rule 116 filed July 29, 1994 (Paper No. (continued...))

Appeal No. 95-3421
Application 08/045,323

the application, stand withdrawn from consideration as being directed to a nonelected invention. 37 CFR § 1.142(b).

Claim 21 is representative of the appealed subject matter, and reads:

21. An article of manufacture for disinfecting a medical sharp for use on a patient, comprising:

a medical sharp having a syringe housing and coupled needle with a tip; and

a disinfectant housing means integrally coupled to said syringe housing, said disinfectant housing means for holding disinfectant and including a disinfectant reservoir and a reservoir sleeve in communication with said reservoir, said reservoir sleeve of said disinfectant housing means being initially held fixed apart from the tip before use of said needle and after use of said needle said reservoir sleeve is displaceable away from said syringe housing to at least partially enclose said needle, including the tip, and said needle and the tip remain in their fixed positions relative to said syringe housing before and after use of said medical sharp.

The references applied by the examiner in the final rejection are:

²(...continued)
6), the examiner included claim 19 as one of the "claims rejected" in part 3 of the Advisory Action of August 22, 1994 (Paper No. 9), and as one of the claims under rejection in the examiner's answer. However, in view of the indication in Paper No. 9 that the proposed amendment would be entered upon the filing of an appeal, we will consider claim 19 as having been cancelled.

Appeal No. 95-3421
Application 08/045,323

Armao	3,134,380	May 26,
1964		
Hall	4,416,663	Nov.
22, 1983		
Miskinyar	4,894,054	Jan.
16, 1990		
Spier et al. (Spier)	4,921,490	May 1,
1990		
Hart	5,188,614	Feb.
23, 1993		
Boese	5,195,983	Mar. 23,
1993		

The claims stand finally rejected under 35 U.S.C. § 103
as unpatentable over the following combinations of references:

1. Claims 9, 11, 12, 14, 16, 20 and 21, over Hall in view of Boese or Spier.
2. Claims 13 and 18, over Hall in view of Boese or Spier, further in view of Armao.
3. Claims 10 and 15, over Hall in view of Boese or Spier, further in view of Miskinyar.
4. Claim 17, over Hall in view of Boese or Spier, further in view of Hart.

We will first consider the rejection of claim 21, the broadest claim on appeal.

Appellant and the examiner both seem to agree (brief, page 4; answer, page 4) that the recited structure differs

Appeal No. 95-3421
Application 08/045,323

from that of Hall in that Hall does not disclose a reservoir sleeve which is "initially held fixed apart from the tip before use." Rather, in the Hall apparatus, the tip 18 of needle 12 is within the sleeve 26 before use (col. 5, lines 4 to 11). The examiner, however, contends that such a modification of the Hall syringe would have been obvious because (answer, pages 3 to 4):

if one were willing to forego the advantages of having the disinfecting reservoir contact the needle before use (i.e. assuring that the needle is sterile before use) as does Hall, it would have been obvious to one of ordinary skill in the art to "fix" or maintain the sleeve away from the needle until after use.

Also, referring to the needle guard disclosed by Boese and the lockable spring/cover of Spier, the examiner asserts that (answer, page 4):

It would have been obvious to one of ordinary skill in the art to use the retraction/extension system of either Spier et al or Boese in the invention of Hall when one did not wish the sleeve **26** to come into contact with the needle until after use or if it were felt that the sleeve would interfere with use if not in a locked retracted position during use.

After fully considering the record in light of the arguments presented in appellant's brief and the examiner's

answer, we conclude that the subject matter recited in claim 21 is patentable over the prior art applied.

Under §103, the teachings of references can be combined only if there is some teaching, suggestion or incentive to do so. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). We do not find any such teaching or suggestion here. The purpose of the Hall apparatus is to automatically sterilize the syringe needle after each inoculation, while still permitting rapid successive uses of the same syringe (col. 1, lines 35 to 39). In the Spier and Boese syringes, by contrast, the shield or guard is located over the end of the needle after use, which would prevent rather than allow rapid reuse of the same needle. As we understand the examiner's position, it is that it would have been obvious to utilize the guard-operating system of Spier or Boese to control the action of Hall's disinfectant reservoir/sleeve 26, but we perceive no motivation for one of ordinary skill to do this, for the sleeve would then be locked in the forward position after one use and the needle could not be rapidly reused. We also do not consider that there would be any suggestion to one of

Appeal No. 95-3421
Application 08/045,323

ordinary skill to fix sleeve 26 of Hall away from the tip of the needle prior to its first use; since the purpose of Hall's apparatus is to allow a multitude of inoculations to be made by the same needle in rapid succession, it is not evident what would be gained by modifying it in this fashion.

Accordingly, the rejection of claim 21 will not be sustained. The rejection of claims 9, 11, 12, 14, 16 and 20, which are more limited than claim 21 and are rejected over the same combination of references, will likewise not be sustained. We also will not sustain the rejections of claims 10, 13, 15, 17 and 18, since the additional references applied thereagainst do not supply the deficiencies noted with regard to the combination of Hall in view of Boese or Spier.

Conclusion

The examiner's decision to reject claims 9 to 18, 20 and 21 is reversed.

REVERSED

Appeal No. 95-3421
Application 08/045,323

	IAN A. CALVERT)	
	Administrative Patent Judge)		
)		
)		
)		
	NEAL E. ABRAMS)	BOARD OF
PATENT	Administrative Patent Judge)		APPEALS AND
)		INTERFERENCES
)		
)		
	MURRIEL E. CRAWFORD)	
	Administrative Patent Judge)		

Appeal No. 95-3421
Application 08/045,323

Michael D. Rechtin
9080 N. Greenbrook Court
River Hills, WI 53217